REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on July 14, 2005, the Examiner rejected Claim 8 under 35 U.S.C. §101, stating the claimed invention is directed to non-statutory subject matter. The Examiner also rejected claims 1, 3-11 and 13-29 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,905,246 to Fajkowski. The Examiner also rejected claims 2 and 12 under 35 U.S.C. §103(a) as being unpatentable over Fajkowski in view of U.S. Patent No. 6,330,543 to Kepecs. Accordingly, Applicants respectfully provide the following.

1. Claim Rejections under 35 U.S.C. §101.

The Examiner rejected Claim 8 under 35 U.S.C. §101, stating the claimed invention is directed to non-statutory subject matter. Applicants respectfully traverse.

The United States Patent and Trademark Office and the United States Court of Appeals for the Federal Circuit treat the utility requirement of 35 U.S.C. § 101 as a relatively low bar to patentability. For example, the MPEP advises examiners to impose a rejection based on lack of utility only if the claimed invention is not "useful for any particular purpose." See MPEP 2107 (emphasis added). The MPEP requires only "one single credible assertion of specific and substantial utility for each claimed invention to satisfy the utility requirement." Id. (emphasis added). In addition, the Federal Circuit said:

> [The Court] never intended to create an overly broad, fourth category of subject matter excluded from Section 101. Rather, at the core of the Court's analysis . . . lies an attempt by the Court to explain a rather straightforward concept, namely, that certain types of mathematical subject matter, standing alone, represent

> nothing more than abstract ideas until reduced to some type of practical application, and thus that subject matter is not, in and of itself, entitled to patent protection.

In re Alappat, 33 F.3d 1526, 1543 (Fed. Cir. 1994)(emphasis added). Consequently, it is not surprising that the Federal Circuit has routinely upheld claims as sufficient under Section 101. For example, in In re Alappat and State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368 (Fed. Cir. 1998), the court upheld claims for machines that achieved certain results. In In re Alappat, a machine used mathematical algorithms to transform data into smooth waveforms. In State Street, a machine used mathematical calculations to transform data into a final share price. In addition, in Arrhythmia Research Technology Inc. v. Corazonix Corp., the court held that the transformation of electrocardiograph signals from a patient's heartbeat through a series of mathematical calculations was useful because it gave information about the condition of the patient's heart. 958 F.2d 1053 (Fed. Cir. 1992).

Similar to Arrhythmia, the present invention produces a useful result directed to the technological art of coupon and shopping technology. Contrary to the Examiner's rejection, the present invention must not include the use of computer technology within the recited steps. Applicants respectfully submit that the present invention produces a useful result directed to the technological art of coupon and shopping technology and satisfies MPEP 2107's credible assertion requirement for utility.

Consequently, Applicants respectfully request withdrawal of the Examiner's rejections of claim 8 under 35 U.S.C. §101.

2. Claim Rejections Under 35 U.S.C. §102(b).

The Examiner rejected claims 1, 3-11 and 13-29 under 35 U.S.C. §102(b) as being anticipated by Fajkowski. In response, Applicants have amended claims 1, 8, 17, 26 and 29 and have cancelled claims 7, 14, and 18-20. In light of the amended claims, Applicants respectfully provide the following response and request withdrawal of the rejection under 35 U.S.C. §102(b).

M.P.E.P 706.02 provides that "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." Applicants respectfully submit that Fajkowski does not teach a purchaser computer device that is configured to manage the electronic coupon, as is now claimed in amended claim 1. Because Fajkowski does not disclose this limitation, it fails to anticipate the claimed invention under 35 U.S.C. § 102(b). Therefore, Applicants respectfully request withdrawal of the rejection of independent claim 1, as well as dependent claims 3-6 under 35 U.S.C. § 102(b).

Applicants also respectfully submit that Fajkowski does not teach the method and computer program products claimed in amended claims 8, 26 and 29 which include the steps for determining the validity of using a second electronic coupon and comparing the electronic coupon with the second electronic coupon to determine which electronic coupon is preferred, wherein the benefit provided to the user corresponds to the preferred electronic coupon. Applicants respectfully submit that Fajkowski only discloses a consideration of more coupons, not a determination of validity and comparison, as claimed above. Because Fajkowski does not disclose these limitations, it fails to anticipate the claimed invention under 35 U.S.C. § 102(b).

Therefore, Applicants respectfully request withdrawal of the rejection of independent claims 8, 26 and 29, as well as dependent claims 9-11, 13, 15-16, and 27-28 under 35 U.S.C. § 102(b).

Applicants also respectfully submit that Fajkowski does not teach the method claimed in amended claim 17, which includes the steps for providing the first electronic coupon at the first computer device, wherein the step for providing the first electronic coupon comprises the steps for populating a database on a server with a plurality of downloadable electronic coupons, wherein the first electronic coupon is one of the plurality of downloadable electronic coupons; and selectively transmitting the first electronic coupon from the first computer device to the second computer device to enable a benefit to be provided to a user of the second computer device, wherein the step for selectively transmitting comprises the steps for: providing access to the database; receiving a request for downloading the first coupon from the data base; and downloading the first electronic coupon in response to the request, wherein the request is initiated automatically based on preset criteria. Applicants respectfully submit that Fajkowski only discloses pre-selecting coupons and does not disclose the above-mentioned limitations, including preset criteria used in selecting coupons. Because Fajkowski does not disclose these limitations, it fails to anticipate the claimed invention under 35 U.S.C. § 102(b). Therefore, Applicants respectfully request withdrawal of the rejection of independent claim 17, as well as dependent claims 21-25 under 35 U.S.C. § 102(b).

3. Claim Rejections under 35 U.S.C. §103(a).

The Examiner rejected claims 2 and 12 under 35 U.S.C. §103(a) as being unpatentable over Fajkowski in view of Kepecs. In response, Applicants have amended independent claims 1 and 8, from which claims 2 and 12 depend. In light of the amended claims, Applicants respectfully provide the following response and request withdrawal of the rejection under 35 U.S.C. §103(a).

An invention is unpatentable under Section 103 "if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains." To establish a *prima facie* case of obviousness, three criteria must be met. "First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2142.

Applicants respectfully submit that Fajkowski does not teach or suggest all the claim limitations. For instance, Applicants respectfully submit that Fajkowski does not teach a purchaser computer device that is configured to manage the electronic coupon, as is now claimed in amended claim 1. Because Fajkowski does not disclose this limitation, it fails to make the claimed invention obvious under 35 U.S.C. § 103(a). Therefore, Applicants respectfully request withdrawal of the rejection of claim 2, which depends from amended independent claim 1, under 35 U.S.C. § 103(a).

In addition, Applicants also respectfully submit that Fajkowski does not teach the method claimed in amended claim 8 which includes the steps for determining the validity of using a second electronic coupon and comparing the electronic coupon with the second electronic coupon to determine which electronic coupon is preferred, wherein the benefit provided to the user corresponds to the preferred electronic coupon. Applicants respectfully submit that Fajkowski only discloses a consideration of more coupons, not a determination of validity and comparison, as claimed above. Because Fajkowski does not disclose these limitations, it fails to make the claimed invention obvious under 35 U.S.C. § 103(a). Therefore, Applicants respectfully request withdrawal of the rejection of dependent claim 12, which depends from amended independent claim 1, under 35 U.S.C. § 103(a).

In conclusion, Applicants respectfully submit that the present invention is not obvious because none of the prior art cited, alone or in combination with each other, teaches or suggests all of the claim limitations of the present invention. Thus, Applicants respectfully request withdrawal of the rejection of dependent claims 2 and 12 under 35 U.S.C. § 103(a).

CONCLUSION

If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

DATED this 14 day of October, 2005.

Respectfully submitted,

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